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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,889	06/25/2003	Hiroki Kobayashi	R2184.0239/P239	2305
24998 7590 06/18/2009 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
NEWAY, SAMUEL G				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/602,889

**Applicant(s)**

KOBAYASHI, HIROKI

**Examiner**

SAMUEL G. NEWAY

**Art Unit**

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4, 6 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This is responsive to the amendment after non-final filed on 09 March 2009.
2. Claims 4, 6, and 14 are pending and considered below.

### ***Response to Amendment***

3. Claims 4 and 6 were indicated as allowable in the last office action, however further search and consideration have uncovered prior art which read on all the pending claims as shown herein below. The Examiner regrets any inconvenience this may cause.
4. The Claim Objections are withdrawn in view of Applicant's amendments.
5. The 35 USC 101 rejections are withdrawn in view of Applicant's amendments.

### ***Claim Objections***

6. Claim 4 is objected to because of the following informalities: in line 2, it is believed "performing initial print setup in a computer" should be 'performing initial print setup in the computer'.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 6, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crespo et al (US PGPub 2003/0046682) in view of Machida (US PGPub 2002/0083131).

Claim 4:

Crespo discloses a software-installing method for installing a plurality of items of software in a computer and simultaneously performing initial setup in the computer, so as to use one of a plurality of devices connected to the computer, the method comprising the steps of (Abstract):

acquiring a template of a scenario (response file template), the scenario (response file) being a file describing procedures for installing the software, and the template including one or more parameters representing incomplete information ([0117], also see for example the Abstract and [0005] where response files are disclosed as files describing procedures for installation);

reading the template to determine whether the template contains one or more parameters representing incomplete information, and subsequently acquiring setting information corresponding to the one or more parameters by searching an installation database, based on said computer or a user of said computer ("First, `SDCONF` searches for the `SRC` file associated with the respective machine to be installed, using the name of the Machine to be installed as the search

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argument", [0117]), the installation database being located outside said computer (Fig. 1, item 100 and related text);

producing the scenario which is specific to said computer by incorporating acquired setting information into at least one of the one or more parameters of said template ("`SDCONF` builds the operating system response-files by filling the operating system response file template with the specific data read from the SRC file", [0117]);

inputting the produced scenario to an installation program; and installing said installation program and said setting information into said computer ("The function-specific program that installs the middleware products and SD packages", [0117]).

However, even if Crespo discloses that the setting information could be related to many computer components (video adapter, keyboard, network adapter ... see [0107]), Crespo does not explicitly a printer as one of these components. In other words, Crespo does not explicitly disclose the setting information being print setting information. Crespo also does not explicitly disclose the installation database search being processed by the computer where the installation is performed.

Machida discloses a similar software-installing method for installing a software on a computer and simultaneously performing initial print setup in the computer, so as to use a plurality of printing devices connected the computer through a network (see [0004] and [0012]). Machida performs these steps by

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searching, acquiring, and installing print setting information (property information list) ([0069] and [0073]) and where the searching is processed by said computer ([0074]).

It would have been obvious to one with ordinary skill in the art at the time of the invention to have installed Machida's acquired print setup information using Crespo's method in order to set information for a printer (see Machida [0004]).

Claim 6:

Crespo and Machida disclose the method of claim 4 as shown above. Crespo does not explicitly disclose a processor readable medium storing program code (Fig. 1, item 3 and related text) means for performing the method of claim 4. Machida discloses such a medium (Fig. 1, item 3 and related text).

Implementing a method as software on a computer readable medium would be an obvious modification to one of ordinary skill in the art of software installing, at the time of applicant's invention, so as to facilitate loading the software onto a computer to perform the steps listed above.

Accordingly, claim 6 is rejected with the same rationale as applied above with respect to method claim 4.

Claim 14:

Crespo discloses a server (Fig. 1, item 108 and related text), comprising: a first element configured to acquire a template of a scenario (response file template), the scenario (response file) being a file describing procedures for installing the software, and the template including one or more

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parameters representing incomplete information ([0117], also see for example the Abstract and [0005] where response files are disclosed as files required for installation);

a second element configured to read the template to determine whether the template contains one or more parameters representing incomplete information, and to subsequently acquire setting information corresponding to the one or more parameters by searching an installation database, and wherein said searching is based on a computer or a selection by a user of said computer ("First, `SDCONF` searches for the `SRC` file associated with the respective machine to be installed, using the name of the Machine to be installed as the search argument", [0117]); the installation database being located outside said computer (Fig. 1, item 100 and related text)

a processor configured to produce the scenario which is specific to said computer by incorporating acquired setting information into at least one of the one or more parameters of said template ("`SDCONF` builds the operating system response-files by filling the operating system response file template with the specific data read from the SRC file", [0117]);

a third element configured to input the produced scenario to an installation program; and an installing element configured to install said installation program and said setting information into said computer ("The function-specific

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program that installs the middleware products and SD packages", [0117]).

However, even if Crespo discloses that the setting information could be related to many computer components (video adapter, keyboard, network adapter ... see [0107]), Crespo does not explicitly a printer as one of these components. In other words, Crespo does not explicitly disclose the setting information being print setting information. Crespo also does not explicitly disclose the installation database search being processed by the computer where the installation is performed.

Machida discloses a similar software-installing method for installing software on a computer and simultaneously performing initial print setup in the computer, so as to use a plurality of printing devices connected the computer through a network (see [0004] and [0012]). Machida performs these steps by searching, acquiring, and installing print setting information (property information list) ([0069] and [0073]) and where the searching is processed by said computer ([0074]).

It would have been obvious to one with ordinary skill in the art at the time of the invention to have installed Machida's acquired print setup information using Crespo's method in order to set information for a printer (see Machida [0004]).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL G. NEWAY whose telephone number is (571)270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/  
Supervisory Patent Examiner, Art Unit 2626

/S. G. N./  
Examiner, Art Unit 2626